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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO
09 982,157	10 17 2001	William R. Perrault	28341 6301A.US	7525

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EXAMINER

SHAMEEM, GOLAM M

ART UNIT PAPER NUMBER

1626

DATE MAILED: 08 13 2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/982,157

Applicant(s)

PERRAULT ET AL.

Examiner

Golam M M Shameem

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 28 May 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) 1-58 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-6, 23-28 and 57 (in part), drawn to a secondary alcohol compound and a method of preparing of the compound, classified in class 564, subclass various, depending on species election. If this group is elected, a further election of a single disclosed species is also required. Generic claim 57 reading on the elected compound can be prosecuted together with the elected compounds to the extend of the elected compounds.
- II. Claims 7-12, drawn to an ester compound of structural formula as shown in claim 7, classified in class 560, subclass various, depending on species election. If this group is elected, a further election of a single disclosed species is also required. Generic claim 7 reading on the elected compound can be prosecuted together with the elected compounds to the extend of the elected compounds.
- III. Claims 13-16, 29-31 and 57 (in part), drawn to an epoxide compound of structural formula as shown in claim 13, classified in class 549, subclass various, depending on species election. If this group is elected, a further election of a single disclosed species is also required. Generic claim 57 reading on the elected compound can be prosecuted together with the elected compounds to the extend of the elected compounds.
- IV. Claims 17, 20-22, 32-40 and 57-58 (in part), drawn to the compound, and a method of preparing of the compound, classified in class 548, subclass various, depending on species election. If this group is elected, a further election of a single disclosed species is also required. Generic claim 58 reading on the elected compound can be prosecuted together with the elected compounds to the extend of the elected compounds.

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V. Claims 41-48, drawn to a process of preparing of a compound classified in class 548, subclass various, depending on species election. If this group is elected, a further election of a single disclosed species being made by the process is also required. Generic claim 41, reading on the elected process can be prosecuted together with the elected species to the extend of the elected compounds.

VI. Claims 49-56, drawn to another method of preparing of a compound classified in various class and subclass, depending on species election. If this group is elected, a further election of a single disclosed species being made by the process is also required. Generic claim 49, reading on the elected compound can be prosecuted together with the elected compounds to the extend of the elected compounds.

VII. Claim 58 not encompassed by group IV, drawn to a method of preparing of a compound classified in class 548 and in various subclass, depending on species election. If this group is elected, a further election of a single disclosed compound is also required.

VIII. Claims 18 and 19, drawn to the intermediate compound of formula classified in class 546, subclass various, depending on species election. If this group is elected, a further election of a single disclosed species is also required. Generic claim 18 reading on the elected compound can be prosecuted together with the elected compounds to the extend of the elected compounds.

The inventions are distinct, each from the other because of the following reasons:

The above groups are identified as general areas. Accordingly, as groups they are independent or distinct, for example, group I-IV differ materially in structure and in element, group V-VII are alternative process for making some of the products of group I-IV and each

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process has different reactive steps and conditions, group VIII is distinct because they are art recognized divergent compounds which are structurally different from one another.

Invention Groups I and IV-VII are related as process of making and product made. The inventions can be shown to be distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product can be made by another material different process (MPEP 806.05(f)). In the instant case, the product as claimed can be made by another materially different process. The process in Group V and the process in Group VI are processes for preparing the same compound. Therefore, the product as claimed can be made at least one materially different process. Therefore a separate search considerations are involved, which would impose a burden if unrestricted. Additionally, besides performing a class/subclass search, the examiner performs a commercial data base search and an automated patent system (text) search.

Additionally, besides performing a class/subclass search, the examiner performs a commercial data base search and an automated patent system (text) search. Moreover, to not restrict would impose a burden in the examination of this application.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

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Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

A telephone call was made to Mr. Mark Hopkins on 7/15/02 to request an oral election to the above restriction requirement, but did not result in an election being made.

Should applicant traverse on the ground that the groups and species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103 (a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Golam Shameem, Ph.D. whose telephone number is (703) 305-0116. The examiner can normally be reached on Monday-Friday from 8:30 AM - 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane, can be reached at (703) 308-4537. The Unofficial fax phone number for this Group is

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(703) 308-7922. The Official fax phone numbers for this Group are (703) 308-4556 or 305-3592.

When filing a FAX in Technology Center 1600, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [joseph.mckane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-1235.

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Celia C Chang, Ph.D.
Primary Patent Examiner
Art Unit 1625, Group 1620
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August 12, 2002